



THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **URANO et al.**

Group Art Unit: 1626 ✓

Serial No.: **09/810,650**

Examiner: **Laura Lynne Stockton**

Filed: **March 15, 2001**

P.T.O. Confirmation No.: 8670

For: **DIAZODISULFONES**

PETITION FOR EXTENSION OF TIME

Commissioner for Patents
Washington, D.C. 20231

Date: December 6, 2002

Sir:

Applicants petition the Commissioner for Patents to extend the time for response to the Office Action dated September 6, 2002 for one month from November 6, 2002 to December 6, 2002.

Attached please find a check in the amount of \$110.00 to cover the cost of the extension for a large entity. In the event that any additional fees are due in connection with this paper, please charge our Deposit Account No. 01-2340. Two copies of this paper are enclosed herewith.

Respectfully submitted,

ARMSTRONG, WESTERMAN & HATTORI, LLP

Scott M. Daniels

Attorney for Applicants
Reg. No. 32,562

SMD/rer

Atty. Docket No. **910094RI**
Suite 1000, 1725 K Street, N.W.
Washington, D.C. 20006
(202) 659-2930



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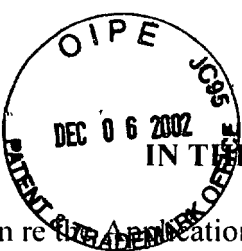
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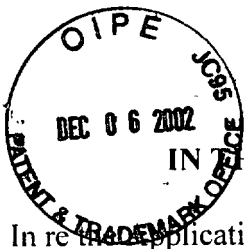
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P.T.O. Confirmation No.: 8670

For: **DIAZODISULFONES**

AMENDMENT UNDER 37 CFR §1.111

Commissioner for Patents
Washington, D.C. 20231

December 6, 2002

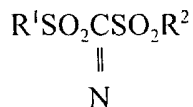
Sir:

In response to the Office Action dated **September 6, 2002**, extended to **December 6, 2002** by a 1 month Petition for Extension of Time, please amend the above-identified application as follows:

IN THE CLAIMS:

Please add the following new claim 10:

10. (New) A diazodisulfone compound of the formula:



wherein R¹ is cyclohexyl; and R² is cyclohexyl.

REMARKS

Claims 8 and 9 have been rejected; claim 7 has been indicated to be in condition for allowance; and claim 10 has been added to more particularly and distinctly claim the subject matter to which the Applicants regard as their invention. It is believed that this Amendment is fully responsive to the Office Action dated **September 6, 2002**.

Essentially, the Examiner has maintained the rejection of claims 8 and 9 for the same reasons as in the previous Office Action. According to the Examiner, those claims lack written description support in the Japanese priority application and are therefore invalid over the *Pawlowski* patent; also, the Examiner states that claims 8 and 9 lack written description support in the present U.S. application and are therefore invalid under 35 U.S.C. §112, first paragraph. Applicants respectfully submit that the Examiner's position is not supported by the relevant facts and is contrary to the relevant law. Specifically, both the U.S. application and the Japanese priority application support the pending claims and *Pawlowski* is therefore not prior art.

1. The Examiner's Position

The Examiner states that the definitions of the two R groups in the formulas of claims 8 and 9 are not supported by the U.S. specification, though there is no explanation of why those R group definitions are not supported.¹

The Examiner then states that she is responding to Applicants' arguments presented in the

¹ See MPEP §706.03(c) regarding such explanations.

U.S. Patent Application Serial No. 09/810,650

Amendment filed May 22, 2002. She states that "Applicants have not pointed out where the claimed subject matter¹ is described *as such* in the specification." (Emphasis added). The Examiner does not reply to the detailed explanation on page 7 of the Amendment of the support in the U.S. application, which explanation is incorporated herein by reference. Also, the Examiner dismisses the Tockman Declaration filed May 22, 2002 because it does not address the issue of support for the claims in the U.S. application.²

Finally, the Examiner states that she is replying to Applicants' argument that the claims are valid over the prior art because they are supported by the U.S. application and the priority application and therefore **Pawlowski** is not prior art against the present claims. The Examiner states merely that claims are not supported by the U.S. application or the priority application. The only explanation offered for this conclusion is the Examiner's reference to the CAFC decision regarding claims 2 and 3 which recited clearly different subject matter from the present claims and have been canceled.

II. Applicants' Response

Applicants respectfully submit that their claims are supported by the earlier applications and that **Pawlowski** is not prior art. Applicants believe that the pending rejections are incorrect for the following reasons.

² The Tockman Declaration addressed only the Japanese application because the written description support was clearer in the U.S. application, *i.e.*, if there is support in the Japanese application, there is also support in the U.S. application.

U.S. Patent Application Serial No. 09/810,650

First, the Examiner states that the claims lack support in both the U.S. and the Japanese applications, but fails to explain why there is no support.

Second, as indicated above, the Examiner uses the expression "as such" in the last line of page 2 of the Action. The expression shows that the Examiner is requiring that the precise words of the claims also appear in the applications, to satisfy the written description requirement. Such a requirement is a clear violation of precedent. If the essence of the original disclosure supports the new claim limitation, the new limitation is not new matter. *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989). *Ipsis verbis* support is not necessary.

Third, claims 8 and 9 are quite different from claims 2 and 3. Accordingly, the Examiner cannot rely upon the CAFC decision regarding claims 2 and 3 to reject claims 8 and 9. Each claim of patent must be separately analyzed for compliance with the written description requirement. *Vas-Cath Inc. v. Nahurkar*, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991).

Fourth, the Examiner fails to address the comments in the Tockman Declaration regarding the support in the Japanese application. In the present Declaration, in which Dr. Tockman repeats his earlier remarks regarding the Japanese application and adds remarks regarding the U.S. application and claim 10, he makes the following critical points.

- A. The definition of R^1_0 and R^2_0 in formula [1] of the Japanese Patent application is inclusive of "a C_{1-10} straight-chain, branched or cyclic alkyl group." (Page 9). R^1_0 and R^2_0 are further defined at page 14 of that Application (as translated) as inclusive of "methyl, ethyl, propyl, butyl, amyl, hexyl, octyl and decyl group."
- B. The compounds of claims 8 and 9 of the Preliminary Amendment are compounds of formula [1] in the Japanese Patent application where both of R^1_0 and R^2_0 are a cyclohexyl group (claim 8) and where both of R^1_0 and R^2_0 are a branched butyl group (claim 9).

U.S. Patent Application Serial No. 09/810,650

- C. The compounds of claims 8 and 9 of the Preliminary Amendment are compounds of formula (I) in U.S. Patent No. 5,216,135 where R^1 is cyclohexyl (2:39) and R^2 is cyclohexyl (2:47) (in the case of claim 8), and R^1 is an isobutyl group, a sec-butyl group or a tert-butyl group (2:33-34) and R^2 is an isobutyl group, a sec-butyl group or a tert-butyl group (2:43-44) (in the case of claim 9).
- D. The compound of claim 10 is compound of formula [1] in the Japanese Patent application where both of R^1_0 and R^2_0 are cyclohexyl.
- E. The compound of claim 10 is compound of formula (I) in U.S. Patent No. 5,216,135 where R^1 is cyclohexyl (2:39) and R^2 is cyclohexyl (2:47).
- F. Based on his extensive experience in matters relating to the synthesis of organic compounds, it is his opinion that a person having an undergraduate degree in chemistry and several years experience in synthesizing organic compounds would know that "a C_{1-10} straight-chain, branched or cyclic alkyl group" is shorthand for and inclusive of each and every such alkyl group have 1-10 carbon atoms. This is particularly the case in view of the further description of the straight-chain, branched or cyclic alkyl group at page 14 of the Japanese application.
- G. Based on his extensive experience in the matter relating to the synthesis of organic compounds, it is my opinion that a person having an undergraduate degree in chemistry and several years experience synthesizing organic compounds would know that the category of a branched butyl is synonymous with an "isobutyl group, a sec-butyl group or a tert-butyl group."
- H. It is his further opinion that the Japanese patent Application establishes to an organic chemist of ordinary skill in the art that the inventors in the Japanese Patent Application were in possession of the compounds described in claims 8, 9 and 10.
- I. It is also his opinion that U.S. Patent No. 5,216,135 establishes to an organic chemist of ordinary skill in the art that inventors in the '135 patent were in possession of the compounds described in claims 8, 9 and 10.

For each of the above reasons, Applicants submit that their claims are patentable over the prior art and supported by the specification.

III. Conclusion


In view of the aforementioned amendments and accompanying remarks, claims, as amended, are in condition for allowance, which action, at an early date, is requested.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicants undersigned attorney at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, WESTERMAN & HATTORI, LLP


Scott M. Daniels
Attorney for Applicants
Reg. No. 32,562

SMD/rer

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Suite 1000, 1725 K Street, N.W.
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(202) 659-2930



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PATENT TRADEMARK OFFICE

Enclosures: Declaration of AI Tockman



Re-exam

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application/reexamination of: **URANO et al.**

U.S. Patent No. **5,216,135**

Reexamination Control No.: **90/004,812**

Filed: **October 23, 1997**

Reissue Serial Number: **09/810,650**

Art Unit: **1626**

Issue Date: **June 1, 1993**

Examiner: **Laura Lynne Stockton**

DECLARATION

1. I am the declarant who made the Declaration of May 20, 2002 in the above-identified reissue Application.
2. This Declaration is similar to my previous Declaration but supplemented to include my opinion with regard to claim 10 in the amendment submitted herewith.
3. I received a Ph.D. in organic chemistry from Northwestern University in 1954.
4. After receiving that degree, I was employed in the industry synthesizing organic compounds. Working with me were laboratory assistants having undergraduate degrees in chemistry.
5. I was given copies of and have read the following materials:

The PRELIMINARY AMENDMENT dated March 15, 2001, in the Reissue Application of U.S. Patent No. 5,216,135;

The RESPONSE dated May 22, 2002, in that application;

U.S. Patent No. 5,216,135;

An English translation of Japanese Patent Application No. 2-19614;

The DECISION in IN RE WAKO PURE CHEMICAL INDUSTRIES LTD, dated February 1, 2001; and



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **URANO et al.**

Group Art Unit: **1626**

Serial No.: **09/810,650**

Examiner: **Laura Lynne Stockton**

Filed: **March 15, 2001**

P.T.O. Confirmation No.: 8670

For: **DIAZODISULFONES**

SUPPLEMENTAL AMENDMENT

Commissioner for Patents
Washington, D.C. 20231

December 13, 2002

Sir:

In response to the Office Action dated **September 6, 2002**, applicants hereby submit the executed original of the Declaration of Albert Tockman filed with the Amendment of December 6, 2002.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, WESTERMAN & HATTORI, LLP

Scott M. Daniels
Attorney for Applicants
Reg. No. 32,562

SMD/rer

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PATENT TRADEMARK OFFICE

Enclosures: Declaration

The attached copy of claim 10.

6. The definition of R^1_0 and R^2_0 in formula [1] of the Japanese Patent application is inclusive of "a C_{1-10} straight-chain, branched or cyclic alkyl group." (Page 9). R^1_0 and R^2_0 are further defined at page 14 of that Application (as translated) as inclusive of "methyl, ethyl, propyl, butyl, amyl, hexyl, octyl and decyl group."
7. The compounds of claims 8 and 9 of the Preliminary Amendment are compounds of formula [1] in the Japanese Patent application where both of R^1_0 and R^2_0 are a cyclohexyl group (claim 8) and where both of R^1_0 and R^2_0 are a branched butyl group (claim 9).
8. The compounds of claims 8 and 9 of the Preliminary Amendment are compounds of formula (I) in U.S. Patent No. 5,216,135 where R^1 is cyclohexyl (2:39) and R^2 is cyclohexyl (2:47) (in the case of claim 8), and R^1 is an isobutyl group, a sec-butyl group or a tert-butyl group (2:33-34) and R^2 is an isobutyl group, a sec-butyl group or a tert-butyl group (2:43-44) (in the case of claim 9).
9. The compound of claim 10 is a compound of formula [1] in the Japanese Patent application where both of R^1_0 and R^2_0 are cyclohexyl.
10. The compound of claim 10 is a compound of formula (I) in U.S. Patent No. 5,216,135 where R^1 is cyclohexyl (2:39) and R^2 is cyclohexyl (2:47).
11. Based on my extensive experience in matters relating to the synthesis of organic compounds, it is my opinion that a person having an undergraduate degree in chemistry and several years experience in synthesizing organic compounds would know that "a C_{1-10} straight-chain, branched or cyclic alkyl group" is shorthand for and inclusive of each and every such alkyl group have 1-10 carbon atoms. This is particularly the case in view of the further description of the straight-chain, branched or cyclic alkyl group at page 14 of the Japanese application.
12. Based on my extensive experience in the matter relating to the synthesis of organic compounds, it is my opinion that a person having an undergraduate degree in chemistry and several years experience synthesizing organic compounds would know that the category of a branched butyl is synonymous with an "isobutyl group, a sec-butyl group or a tert-butyl group."
13. The paragraph bridging pages 2-3 of the DECISION reads, in part, "The written description requirement does not dictate that the applicant describe the invention exactly. Rather, what is required is that ... the inventor convey with reasonably [sic] clarity to those skilled in the art that the inventor was in possession of the subject matter claimed."

14. It is my further opinion that the Japanese patent Application establishes to an organic chemist of ordinary skill in the art that the inventors in the Japanese Patent Application were in possession of the compounds described in claims 8, 9 and 10.
15. It is also my opinion that U.S. Patent No. 5,216,135 establishes to an organic chemist of ordinary skill in the art that inventors in the '135 patent were in possession of the compounds described in claims 8, 9 and 10.

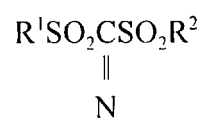
The undersigned declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code and that such willful statements jeopardize the validity of the application or any patent issuing thereon.

Signed this 12th day of December, 2002.

Albert Tockman
Albert Tockman

Q:\FLOATERS\SMD\910094RI and RE\Tockman Declaration 11-12-02

Claim 10. A diazodisulfone compound of the formula:



wherein R¹ is cyclohexyl; and R² is cyclohexyl.



TC 1626
CMI 11E17

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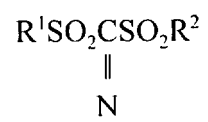
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Signed this th day of , 2002.

Albert Tockman

QA\FLOATERS\SMD\910094RI and REV\Tockman Declaration 11-12-02

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